

**REMARKS**

Claims 1-63 are pending in this application. Claims 1, 30 and 63 are independent claims.

By this amendment, claim 1 is amended, and new claim 63 is added.

**The Claims Define Patentable Subject Matter**

The Office Action makes the following rejections:

(1) claims 1-4, 14 and 30-33 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Yamagata* in view of *Nanba*;

(2) claims 5, 6, 34 and 38 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Yamagata* in view of *Nanba* and further in view of the Tamura patent (JP 09-37125);

(3) claims 7-11, 35-37 and 39-43 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Yamagata* in view of *Nanba* and *Tamura* and further in view of the Tomat patent (US 6,784,925);

(4) claims 12 and 44 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Yamagata* in view of *Nanba* and further in view of the Allen patent (US 5,737,491);

(5) claims 13 and 45 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Yamagata* in view of *Nanba* and the Oie patent (US 6,188,431);

(6) claims 15-21, 29, 46-51 and 55 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Yamagata* in view of *Nanba* and further in view of the Niikawa publication (2002/0101440);

(7) claims 22-26, 52-54 and 56-60 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Yamagata* in view of *Nanba*, *Niikawa* and *Tomat*;

(8) claims 27 and 61 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Yamagata* in view of *Nanba*, *Niikawa* and *Allen*; and

(9) claims 28 and 62 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Yamagata* in view of *Nanba*, *Niikawa* and *Oie*.

The above-noted rejections are respectfully traversed.

In the Office Action, although a plurality of references are being applied in rejecting claims 1-62, it appears that the Examiner is mainly relying upon the combination of *Yamagata* and *Nanba*. As such, our comments will mainly be directed to these aforementioned two base references.

Applicant respectfully submits that the claimed invention is distinguishable from the combination of *Yamagata* and *Nanba* for at least the following reasons:

For example, in the present invention a camera 10 can capture the main image data and store it in a detachable storage medium. A communication device transmits the main image data stored in the detachable storage medium to an external apparatus. An information processing device deletes the main image data stored in the detachable storage medium *after* the communication device transmit it. The information processing device produces reduced image data of the main image data and preferably stores the reduced image data in the detachable storage medium.

In contrast with the present invention, both Yamagata and Nanba (or any combination thereof, assuming these teachings may be combined, which applicant does not admit) fail to teach or suggest transmitting image data stored in a detachable storage medium. For example, Nanba merely discloses data being stored in a non-detachable built-in memory device (image memory 209).

Furthermore, in contrast with the present invention, both Yamagata and Nanba fail to teach or suggest transmitting stored image data to an external apparatus.

For example, Yamagata merely discloses that a selected file is read out of the IC memory card M, and the stored in the image data memory in the camera. The image data is compressed at step S154 and stored in the image memory 35. The system controller in Yamagata deletes the file which was selected and remains stored in the IC memory card M, since the newly compressed image data will be stored. In Yamagata, the newly compressed file stored in the image memory 35 is transferred to the IC memory card M to be stored therein. (see Yamagata, col. 11, line 39 to col. 12, line 3).

In other words, in Yamagata the image data is merely transferred between memories in the digital camera, but is never transferred externally to the camera. The Examiner even concedes that Yamagata fails to disclose transmitting the data externally. (see Office Action, page 3).

In an attempt to make up for the deficiencies found in Yamagata, the Examiner imports Nanba. Specifically, the Examiner alleges that Nanba discloses transmitting image data to an external PC. However, applicant respectfully submits that

even if Nanba discloses transmitting image data to an external PC, Nanba fails to disclose transmitting image data stored in a detachable storage medium to an external device.

For example, while Nanba does transmit data to an external PC, Nanba fails to transmit data that has been stored in a detachable storage medium, as set forth in the claimed invention. Instead, Nanba looks at situations where the memory card is not installed in the camera or the remaining capacity of the memory card is not sufficient, and under such circumstances the photographed image is automatically recorded in the hard disk of the PC. (see Nanba, col. 8, lines 14-18). In other words, Nanba merely chooses between a first and second recording medium, i.e., either in the camera or in the external PC.

As such, the data that is transmitted to the PC (external device) in Nanba is never stored in any medium in the digital camera. As a result, both Yamagata and Nanba fail to disclose transmitting image data that is stored in a detachable storage medium to an external device.

To establish a *prima facie* case of Obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and

not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

Applicant respectfully submits that not only does the combination of Yamagata and Nanba fails to teach or suggest each and every feature as set forth in independent claims 1 and 30 as noted above, but the Examiner has also failed to provide proper motivation for combining Yamagata and Nanba.

Applicant respectfully submits that but for applicant's own disclosure of the specific features involved, i.e., the data form, and the storage thereof after specific steps, the applied references themselves would not have instructed one versed in the art on how to go about selectively reworking and modifying Yamagata's device/process to yield applicant's claimed invention.

Accordingly, applicant submits that the Examiner's 103(a) rejection is predicated upon impermissible hindsight, and not upon a suggestion from the combination of the references applied that would have been derivable by one versed in the art from the references themselves.

In addition, applicant submits that the Office Action has improperly used applicant's invention as a road map to pick and choose features and paste the chosen features together to arrive at the claimed invention, even though the cited references do not provide any teachings, suggestion or motivation to make the modification.

Applicant respectfully submits that the combination of Yamagata and Nanba fail to teach or suggest each and every feature as set forth in the claimed invention.

Applicant respectfully submits that independent claims 1 and 30 are allowable over the combination of Yamagata and Nanba for at least the reasons noted above.

Furthermore, applicant respectfully submits that Tamura, Tomat, Allen, Oie, and Niikawa all fail to make up for the deficiencies found in the combination of Yamagata and Nanba noted above.

As for each of the dependent claims not particularly discussed above, these claims are also allowable for at least the reasons set forth above regarding their corresponding independent claims, and/or for the further features claimed therein.

Accordingly, withdrawal of the rejection of claims 1-62 under 35 U.S.C. §103(a) is respectfully requested.

#### Conclusion

In view of the foregoing, Applicant respectfully submits that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Carolyn T. Baumgardner (Reg. No. 41,345) at (703) 205-8000 to schedule a Personal Interview.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment from or

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credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly, the extension of time fees.

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Respectfully submitted,

By 

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